

REMARKS:

Claims 1-29 are currently pending in the application.

Claims 1-29 stand rejected under 35 U.S.C. § 103(a) over U.S. Publication No. 2002/0035511 A1 to Haji et al. (“*Haji*”) in view of U.S. Patent No. 6,105,004 to Halperin et al. (“*Halperin*”).

The Applicant respectfully submits that all of the Applicant’s arguments and amendments are without *prejudice or disclaimer*. In addition, the Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, the Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. The Applicant further respectfully submits that by not responding to additional statements made by the Examiner, the Applicant does not acquiesce to the Examiner’s additional statements. The example distinctions discussed by the Applicant are considered sufficient to overcome the Examiner’s rejections. In addition, the Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-29 stand rejected under 35 U.S.C. § 103(a) over U.S. Publication No. 2002/0035511 A1 to Haji et al. (“*Haji*”) in view of U.S. Patent No. 6,105,004 to Halperin et al. (“*Halperin*”).

The Applicant respectfully submits that the ***amendments to independent Claims 1, 10, 19, and 28 have rendered moot the Examiner’s rejection of Claims 1-29 and the Examiner’s arguments in support of the rejection of Claims 1-29.*** The Applicant further respectfully submits that amended independent Claims 1, 10, 19, and 28 in their current amended form contain unique and novel limitations that are not taught, suggested, or even hinted at in *Haji* or *Halperin*, either individually or in combination. Thus, the Applicant respectfully traverses the Examiner’s obvious rejection of Claims 1-29 under 35

U.S.C. § 103(a) over the proposed combination of *Haji* or *Halperin*, either individually or in combination.

The Proposed *Haji-Halperin* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims

For example, with respect to amended independent Claim 1, this claim recites:

A ***system for locally generating price quotes***, the system comprising:

a ***network coupled with a plurality of buyers and a plurality of sellers***;

a ***database associated with each of the plurality of buyers***; and
a ***server associated with each of the plurality of buyers***, wherein the server is operable to:

receive one or more pricing tools from one or more of the plurality of sellers, the one or more pricing tools operable to generate one or more price quotes for one or more corresponding sellers;

locally store the one or more pricing tools received from one or more of the plurality of sellers in the database, such that the one or more pricing tools are locally accessible to the server;

access a request for quote (RFQ) specifying an order comprising quantities of one or more items, the RFQ requesting a price quote for the order;

communicate the RFQ to the locally accessible one or more pricing tools;

using the locally accessible one or more pricing tools received from one or more of the plurality of sellers, locally generate one or more price quotes for the order; and

provide the locally generated one or more price quotes for the order for possible further action by the buyer. (Emphasis Added).

In addition, *Haji* or *Halperin*, either individually or in combination, fail to disclose each and every limitation of amended independent Claims 10, 19, 28, and 29.

#1 The Applicant respectfully submits that *Haji* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding a “***system for locally generating price quotes***” and in particular *Haji* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding a “***network coupled with a plurality of buyers and a plurality of sellers***” and a “***database associated with each of the plurality of buyers***”

buyers". In addition, the Applicant respectfully submits that *Haji* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding a "**server associated with a buyer**" wherein the server is operable to "**receive one or more pricing tools from one or more of the plurality of sellers**", the one or more pricing tools operable to generate one or more price quotes for one or more corresponding sellers" and "**locally store the one or more pricing tools received from one or more of the plurality of sellers in the database**", such that the one or more pricing tools are locally accessible to the server". Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Haji* and amended independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent claim 1 from *Haji*.

The Office Action Acknowledges that *Haji* Fails to Disclose Various Limitations Recited in Applicant's Claims

The Applicant respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Haji* fails to disclose the emphasized limitations noted above in amended independent claim 1. Specifically the Examiner acknowledges that *Haji* fails to teach "the specified order comprising **quantities of one or more items**". (31 October 2007 Office Action, Page 5). However, the Examiner asserts that the cited portions of *Halperin* disclose the acknowledged shortcomings in *Haji*. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in *Halperin*.

The Applicant respectfully submits that *Halperin* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding "**access[ing] a request for quote (RFQ) specifying an order comprising quantities of one or more items**", the RFQ requesting a price quote for the order". In particular, the Examiner equates "**quantities of one or more items**" recited in amended independent Claim 1 with the "**purchase information**" disclosed in *Halperin*. (31 October 2007 Office Action, Page 5). However, the "**purchase information**" disclosed in *Halperin* is merely displayed on a screen, but **does not include, involve, or even relate to the quantities of one or more items**, as recited in amended independent Claim 1. (Column 4, Lines 1-4). In contrast, the

“quantities of one or more items” recited in amended independent claim 1 **is associated with a buyer for locally generating price quotes wherein a request for quote is accessed specifying an order which comprises quantities of one or more items.** Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Halperin* and amended independent claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent claim 1 from *Halperin*.

The Examiner’s Official-Notice is improper under MPEP § 2144.03

The Applicant respectfully submits that the Applicant is confused as to what the Examiner teaches by the Official Notice or even to the extent in which the Examiner is taking Official Notice. The Applicant respectfully requests clarification as to the subject matter for which Official Notice is being taken. ***The Applicant respectfully traverses the Official Notice because the asserted facts, as best understood by the Applicant, are not supported by substantial documentary evidence or any type of documentary evidence*** and appear to be the Examiner’s opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight. Furthermore, under these circumstances, it is inappropriate for the Examiner to take Official Notice without documentary evidence to support the Examiner’s conclusion. (See MPEP § 2144.03). ***The Applicant respectfully requests the Examiner to produce authority for the Examiners Official Notice.***

Only “in limited circumstances,” is it “appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection”. (MPEP § 2144.03). “Official notice unsupported by documentary evidence **should only be taken by the examiner** where the facts asserted to be well-known, or to be common knowledge in the art are **capable of instant and unquestionable demonstration as being well-known.**

With respect to the subject Application, the Examiner’s statement that the “Examiner takes Official Notice that encrypting information for preventing unauthorized

parties from revealing the information is old and well known in the art" and that "Examiner takes Official Notice that it would have been obvious to one of ordinary skill in the art to allow the teachings of *Haji* modified by *Halperin* to include the feature of a buyer group comprising two or more buyers buying items as a single entity for sharing better price of the purchased items", ***is not capable of instant and unquestionable demonstration as being well-known.*** (31 October 2006 Office Action, Pages 5-6). As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be '***capable of such instant and unquestionable demonstration as to defy the dispute***' (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961))." (MPEP § 2144.03(A)). (Emphasis Added).

"It is ***never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record,*** as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002)." (MPEP § 2144.03(A)).

"Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that ***general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection.***)". The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in

the next reply after the Office action in which the common knowledge statement was made.” (MPEP § 2144.03(B)). (Emphasis Added).

The Applicant respectfully submit that the Office Action provides no documentary evidence to support the Official Notice taken by the Examiner, yet the asserted facts are not capable of “instant and unquestionable” demonstration as being well-known. The Applicants further submit that the Applicants have adequately traversed the Examiners assertion of Official Notice and direct the Examiner’s attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, if the Examiner continues to maintain the rejection of Claims 1-29 based on the Official Notice, the Applicant respectfully requests that the Examiner provide documentary evidence as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Applicant further respectfully requests that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding as further necessitated by MPEP § 2144.03(C).

The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Haji-Halperin* Combination According to the UPSTO Examination Guidelines

The Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Haji* or *Halperin*, either individually or in combination, and in particular, the Office Action fails to establish a

prima facie case of obviousness based on the “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” (the “Guidelines”).

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc. (KSR)*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at __, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel **“ensure that the written record includes findings of fact** concerning the state of the art and the teachings of the references applied. (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the **“factual findings made by Office personnel are the necessary underpinnings to establish obviousness.”** (*id.*). Further, **“Office personnel must provide an explanation to support an obviousness rejection** under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject application, the Office Action has not shown the ***factual findings necessary to establish obviousness*** or even ***an explanation to support the obviousness rejection*** based on the proposed combination of *Haji* and *Halperin*. The Office Action merely states that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the specified order in *Haji*’s teaching to include quantities of the ordered items as taught by *Halperin*”. (31 October 2007 Office Action, Page 5). The Applicant respectfully disagrees and respectfully submits that the Examiner’s conclusory statement is not sufficient to establish the ***factual findings necessary to establish obviousness*** and is not a sufficient ***explanation to support the obviousness rejection*** based on the proposed combination of *Haji* and *Halperin*.

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (See Phillips v. AWH Corp., 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any ***“obviousness rejection should include***, either explicitly or implicitly in view of the prior art applied, ***an indication of the level of ordinary skill.***” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided ***an indication of the level of ordinary skill.***

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that ***Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.*** (*Id.*). In addition, the Guidelines state that the proper analysis is ***whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.*** (*Id.* and See 35 U.S.C. 103(a)).

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicant's invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to ***explain why the difference(s) between the proposed combination of Haji, Halperin, and the Applicant's claimed invention would have been obvious to one of ordinary skill in the art.*** The Office Action merely states that "so that the buyer can have ***better idea*** of the total costs ***of the order that have multiple purchased items***". (31 October 2007 Office Action, Page 5). The Applicant respectfully disagrees and further respectfully requests clarification as to how this statement ***explains why the difference(s) between the proposed combination of Haji, Halperin, and the Applicant's claimed invention would have been obvious to one of ordinary skill in the art.*** The Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the "key to supporting any rejection under 35 U.S.C. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious.***" (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that "***the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.***" (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that "[R]ejections on ***obviousness cannot be sustained by mere conclusory statements;*** instead, there ***must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.***" (*KSR*, 550 U.S. at __, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

The Applicant respectfully submits that the ***Office Action fails to provide any articulation, let alone, clear articulation of the reasons why the Applicant's claimed invention would have been obvious.*** For example, the ***Examiner has not adequately supported the selection and combination of Haji and Halperin to render obvious the Applicant's claimed invention.*** The Examiner's unsupported conclusory statements that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the specified order in *Haji*'s teaching to include quantities of the ordered items as taught by *Halperin*” and “so that the buyer can have ***better idea*** of the total costs ***of the order that have multiple purchased items***”, ***does not adequately provide clear articulation of the reasons why the Applicant's claimed invention would have been obvious.*** (31 October 2007 Office Action, Page 5). The Applicant respectfully disagrees. For example, how does “***hav[ing] a better idea***” allow the alleged specified order in *Haji*'s to include quantities of the ordered items as allegedly taught by *Halperin* and to what extent does the Examiner purport that “***hav[ing] a better idea***” applies to the subject Application. In addition, the Examiner's unsupported conclusory statement fails to meet any of the Guidelines rationales to render obvious the Applicant's claimed invention.

Thus, if the Examiner continues to maintain the obvious rejection based on the proposed combination of *Haji* and *Halperin*, the Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including an explicit analysis of the rationale relied upon by the Examiner.

The Applicant's Claims are Patentable over the Proposed *Haji-Halperin* Combination

Amended independent Claims 10, 19, 28, and 29 are considered patentably distinguishable over the proposed combination of *Haji* and *Halperin*, for at least the reasons discussed above in connection with amended independent Claim 1.

Furthermore, with respect to dependent Claims 2-9, 11-18, and 20-27: Claims 2-9 depend from amended independent Claim 1; Claims 11-18 depend from amended independent Claim 10; and Claims 20-27 depend from amended independent Claim 19. As mentioned above, each of amended independent Claims 1 10, 19, 28, and 29 are considered distinguishable over *Haji* and *Halperin*. Thus, dependent Claims 2-9, 11-18, and 20-27 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicant respectfully submits that Claims 1-29 are not rendered obvious by the proposed combination of *Haji* and *Halperin*. The Applicant further respectfully submits that Claims 1-29 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of Claims 1-29 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-29 be allowed.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

31 December 2007
Date

/Steven J. Laureanti/signed
Steven J. Laureanti, Registration No. 50,274

BOOTH UDALL, PLC
1155 W. Rio Salado Pkwy., Ste. 101
Tempe AZ, 85281
214.636.0799 (mobile)
480.830.2700 (office)
480.830.2717 (fax)
steven@boothudall.com

CUSTOMER NO. 53184